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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/142,983    09/18/98    JACKSON

J    P50464-1

HM12/0118  
SMITHKLINE BEECHAM CORPORATION  
CORPORATE INTELLECTUAL PROPERTY-UW2220  
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EXAMINER

CRIARES, T

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

01/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/142,983**

Applicant(s)  
**Jackson et al**

Examiner  
**Theodore J. Criares**

Group Art Unit  
**1617**



☒ Responsive to communication(s) filed on Feb 15, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 5, 6, and 10-12 is/are allowed.

☒ Claim(s) 1-4, 7-9, and 13 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1614

## **CLAIMS 1-17 ARE PRESENTED FOR EXAMINATION**

The request filed on November 1, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/142,983 is acceptable and a CPA has been established. An action on the CPA follows.

Claims 1-4, 7-9 and 13-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is a lack of an antecedent basis for the phrase "and wherein the compounds were invented after the priority date of March 26, 1996" relating to future unknown compounds. There is no basis for such terminology in the specification and would not reasonable convey to one skilled in the relevant art that the inventor had possession of the claimed invention. Applicant argues that the claims can encompass narrower limitations than supported by the specification.

However, the language as set forth above renders the claims indefinite since it is claiming compounds which are not presently in existence. In essence the applicant is claiming a perpetual motion machine which is not patentable.

Claims 5, 6 and 10-12 are allowed.


Art Unit: 1614

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.J. Criares whose telephone number is (703) 308-4607. The examiner can normally be reached on Monday -Thursday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, Marianne Cintinis, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

January 10, 2001

  
THEODORE J. CRIARES  
PRIMARY EXAMINER  
GROUP 1200  
1600